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10/764,668	01/26/2004	Huitao Liu	1033-LB1007	8818

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 August 2007</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Binzel et al. (US 2005/0153740).

Regarding claim 1, Binzel teaches a terminal having private content stored in a memory (See abstract), the terminal comprising:

at least one smart card having first IMSI information or a first MSISDN/IMSI combination, that identifies the at least one smart card as an authorized smart card *(Paragraph 0017)*; and

a security function that associates the private content stored in the terminal memory with the first IMSI or first MSISDN/IMSI combination of the at least one authorized smart card to grant access to the private content only to the at least one authorized smart card (Paragraphs 0025 and 0026).

Regarding claims 2 and 12, Binzel teaches the terminal, wherein the terminal comprises a mobile telephone *(Abstract)*.

Regarding claims 3 and 13, Binzel teaches the terminal, wherein the terminal

comprises a communicator *(Abstract)*.

Regarding claims 4 and 14, Binzel teaches the terminal, wherein the at least

one smart card comprises a SIM *(Paragraph 0026)*.

Regarding claim 5, Binzel teaches the terminal, wherein the terminal further

comprises a private content IMSI/MSISDN associated with the private content, wherein

the security function denies access to the private content to a smart card that is not an

authorized smart card and grants access to the private content to an authorized smart

card (Paragraphs 0025 and 0026).

Regarding claims 6,7,10, and 11, Binzel teaches the terminal, wherein the

private content comprises discreet items, and the private content IMSI/MSISDN is

associated with each discreet item *(Paragraphs 0017,0025, and 0026)*.

Regarding claim 8, Binzel teaches the terminal, wherein the terminal comprises

a GSM terminal *(Paragraph 0010)*.

Regarding claim 9, Binzel teaches a method of controlling access to private

content stored in a GSM/SIM mobile terminal (See Abstract), the method comprising the

steps of:

providing the private content with private content IMSI/MSISDN information

(Paragraph 0017);

associating the private content IMSI/MSISDN information with at least one SIM

from a plurality of SIMs, each SIM of the plurality of SIMs including respective

IMSI/MSISDN information (Paragraphs 0025 and 0026);

comparing the private content IMSI/MSISDN information with the IMSI/MSISDN

information of a SIM from the plurality of SIMs to produce a comparison result

(Paragraphs 0025 and 0026);

denying access to the private content when the comparison result is negative

(Paragraphs 0025 and 0026); and

granting access to the private content when the comparison result is positive

(Paragraphs 0025 and 0026).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 15-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Binzel et al. (US 2005/0153740) and in view of Carpenter (US Patent Application

Publication #2005/0176409).

Regarding claim 15, Binzel teaches, a system for preventing unauthorized

access to private content stored in the internal memory of a mobile terminal (Paragraph

0026), the system comprising:

mobile equipment that accesses a wireless network by radio transmission and

reception (inherent), wherein the mobile equipment comprises private content stored on

the internal memory of the mobile equipment, and further wherein the private content, or

a pre-determined portion thereof, is associated with IMSI information unique to an

owner of the private content or the pre-defined portion of the private content (See

Abstract and Paragraphs 0025 and 0026); and

    at least one SIM containing subscriber information and service or application

profiles, wherein the SIM identifies the subscriber by IMSI information stored on the SIM

(Paragraphs 0025 and 0026);

    wherein access to all or to the pre-defined portion of the private content occurs

only when the IMSI/MSISDN information of the SIM correlates to the IMSI/MSISDN

information of the private content, or of the pre-defined portion of the private content,

stored in the memory of the mobile equipment (Paragraphs 0025 and 0026), except

mobile equipment that accesses a wireless network by radio transmission and reception

using 3GPP protocols and at least one SIM containing subscriber information and

service or application profiles, wherein the SIM identifies the subscriber by MSISDN

information stored on the SIM.

    However, in related art, Carpenter teaches mobile equipment that accesses a

wireless network by radio transmission and reception using 3GPP protocols

(Paragraphs 0032,0052,0069) and at least one SIM containing subscriber information

and service or application profiles, wherein the SIM identifies the subscriber by MSISDN

information stored on the SIM (Paragraph 0024).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to provide the above teaching of Carpenter to Binzel in order to

secure the private information that stores in the memory of mobile device.

Regarding claims 16 and 18, the combination of Binzel and Carpenter teach all

the claimed elements in claim 15. In addition, Binzel teaches the terminal, wherein the

private content comprises discreet items, and the private content IMSI/MSISDN is

associated with each discreet item *(Paragraphs 0017,0025, and 0026)*.

Regarding claims 17, the combination of Binzel and Carpenter teach all the

claimed elements in claim 16. In addition, Binzel teaches the system, wherein the

private content comprises one or more of the following items: (a) one or more ring

tones, (b) one or more games, (c) one ore more images, (d) one or more video files, or

(d) one or more audio files *(Paragraph 0025)*.

Regarding claim 19, the combination of Binzel and Carpenter teach all the

claimed elements in claim 18. In addition, Binzel teaches the system, wherein the

private content comprises one or more of the following groups of contact information: (a)

push-to-talk, (b) instant text messaging, (c) instant voice messaging, (d) buddy list, (e)

email addresses, or (f) phone numbers (Paragraphs 0024 and 0026).

Regarding claim 20, the combination of Binzel and Carpenter teach all the

claimed elements in claim 15. In addition, Binzel teaches the terminal, wherein the

terminal comprises a mobile telephone *(Abstract)*.

Response to Arguments

5.   Applicant's arguments, see pages 7-15, filed 08/1/2007, with respect to the

rejection(s) of claim(s) 1-20 under 35 U.S.C. 102(b) have been fully considered and are

persuasive. Therefore, the rejection has been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of Binzel et al. (US

2005/0153740) and Carpenter (US Patent Application Publication #2005/0176409).

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dominic E. Rego whose telephone number is 571-272-

8132. The examiner can normally be reached on Monday-Friday, 8:30 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

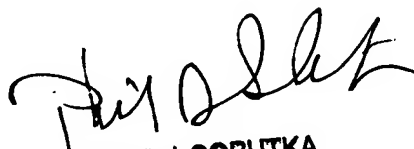Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dominic E. Rego
Tele 571-272-8132

PHILIP J. SOBUTKA
PATENT EXAMINER

10/12/7